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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,249	04/13/2004	Brian Keith Long	000479.00124	5753
22909 7590 11/17/2008 BANNER & WITCOFF, LTD. 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051				
EXAMINER				
WEBER, JONATHAN C				
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3641				
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11/17/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/824,249

**Applicant(s)**

LONG, BRIAN KEITH

**Examiner**

Jonathan C. Weber

**Art Unit**

3641

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 38-42, 44-49, 52-61, 64-71, 74, & 76-87 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 38-42, 44-49, 52-61, 64-71, 74, & 76-87 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

**Pursuant to the responses filed on 13 May 2008 and 5 September 2008**, the claim amendments have been entered into the instant application. There were no amendments to the drawings or specification. Claims 76-87 have been added to the instant application.

### ***Response to Arguments***

**In response to applicant's arguments** concerning the references failing to disclose that the armored panels are formed of a single piece. Examiner asserts that it is well known in the art for an armored panel to be made of several layers or several components, yet the panel still constitutes a single element.

**In response to applicant's arguments** that the references relied upon fail to disclose using the configuration of the individual elements or the uses of each individual element, Examiner offers the following: It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham*, 2 USPQ2d 1647 (1987). It has also been held that rearranging the parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70. Note the references cited with this office action as examples of the potential layouts, configurations, and uses of the individual components of the overall structure.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. **Claims 38, 39, 42, 44-48** are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.K. Patent GB 22,345,069 issued to Skottowe (Skottowe).

Skottowe discloses a modular structure comprising a frame formed from a plurality of frame portions (references 12, 14, 15, 17 and page 2, ¶¶ 4) and a shell formed from a plurality of abutting armored panels (reference 13) formed of a single piece and the shell forming at least a portion of an interior (reference 10) and exterior (reference 9) surface of the modular structure, each of the frame portions being secured to at least one of the armored panels to form discrete units, the units joinable to form the modular structure having a first configuration, the units are joinable to form modular structures having any desirable shapes (see abstract), therefore the units are interchangeable with units from other modular structures having at least a second configuration. The modular structure can be joined with another modular structure to form a larger modular structure. Portions of the armored panels are removable from an interior to form ports. The armored panels comprise a fiber-reinforced polymer, para-aramid fiber (i.e. Kevlar). At least one of the units is hinged to form an entry point. At least one of the units includes an attachment area for mounting weaponry. The frame is positioned adjacent one of the interior surface and the exterior surface. The units define a ceiling, a floor, and walls of the modular structure. The structure comprising a base, at least three armored sides, connected to the base and substantially perpendicular to the base, wherein the at least three armored sides form at least a portion of both the interior surface and exterior surface, an open end including a means for coupling, wherein the means for coupling mates with a corresponding portion of a means for coupling on a second modular structure and wherein the base, the at least three armored sides and the open end form a self-supporting structure. Wherein one of the at least three sides is

removable during use of the modular structure. Wherein two modular structures are joinable. The [a]statements of intended use or field of use, b)"adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"] clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

2. **Claims 50 and 51** are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.K. Patent GB 22,345,069 issued to Skottowe (Skottowe).

Skottowe discloses a modular structure comprising a frame formed from a plurality of frame portions (references 12, 14, 15, 17 and page 2, ¶ 4) and a shell formed from a plurality of abutting armored panels (13) and the shell forming at least a portion of an interior (reference 10) and exterior (reference 9) surface of the modular structure, each of the frame portions being secured to at least one of the armored panels to form discrete units, the units joinable to form the modular structure having a

first configuration, the units are joinable to form modular structures having any desirable shapes (see abstract), therefore the units are interchangeable with units from other modular structures having at least a second configuration. **The frame is positioned adjacent one of the interior surface and the exterior surface. The units define a ceiling, a base (i.e. floor), and walls of the modular structure (page 2 ¶).**

3. **Claims 50 and 51** are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent 4,221,426 issued to Wardill (Wardill).

Wardill discloses a modular structure comprising a frame formed from a plurality of frame portions (references 10, 11, 12) and a shell formed from a plurality of abutting panels (1 and 2) (which may contain metal mesh, i.e. armor) and the shell forming at least a portion of an interior and exterior surface of the modular structure, each of the frame portions being secured to at least one of the armored panels to form discrete units, the units joinable to form the modular structure having a first configuration, the units are joinable to form modular structures having any desirable shapes (see abstract), therefore the units are interchangeable with units from other modular structures having at least a second configuration. The frame is positioned adjacent one of the interior surface and the exterior surface. The units define a ceiling, a floor, and walls of the modular structure (figure 7).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. **Claims 38, 40, 41, 49, 52, 54, 55, 58, 59, 64, 67, 68, 71, 74 and 75** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,351,558 issued to Mueller (Mueller) in view of U.S. Patent 7,210,707 issued to Schroth (Schroth) and U.S. Patent 5,971,177 issued to Carter (Carter).

Mueller discloses a modular structure comprising a frame formed from a plurality of tubular frame portions and a shell formed from a plurality of abutting armored panels, the frame and shell configured to form an elongate shape with a first end area and an opposite second end area, each of the abutting armored panels formed of a single piece and forming at least a portion the shell forming at least a portion of an interior and exterior surface of the modular structure. An interior surface and an exterior surface of the modular structure has no void between the interior surface and exterior surface and a portion of the modular structure includes a curved configuration. Each of the frame portions being secured to at least one of the armored panels to form discrete units, the units being joinable to form the modular structure in any desired configuration, it is inherent that the units are interchangeable with units from other modular structures; some of the units have a curved configuration. A frame (reference 30) extends around the exterior surface of the modular structure. Schroth teaches floor mounted helicopter seats having a four point harness. Carter teaches a portable crane mounted to a truck. All of the component parts are known in the Mueller, Schroth and Carter. The only difference is the combination of the "old elements" into a single device by mounting them into the modular structure. Thus it would have been obvious to one having



ordinary skill in the art to secure the seats within the modular structure and include a mounting area for the crane, since the operation of the crane and seat is in no way dependent on the operation of the other equipment of the structure to achieve the predictable results of the individual elements. The references disclose the claimed invention except for the armored material comprising a para-aramid polymer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the specific material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 1125 USPQ 416. The [a)statements of intended use or field of use, b)"adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"]clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

5. **Claims 38, 39, 42, 46, 47, 52, 53, 56, 57, 60, 64-74, and 76-87** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,076,328 issued to Danhof et al. (Danhof) in view of U.S. Patent 6,250,222 issued to Paz et al. (Paz).

Danhof discloses a modular structure comprising; a frame formed from a plurality of frame portions (fig 21); and a shell formed from a plurality of abutting sheet metal panels (reference 50a-50i)(i.e. armored panels), each of the abutting panels forming at least a portion of an interior and exterior surface of the modular structure, having no void between the interior surface and the exterior surface; each of the frame portions being secured to at least one of the panels to form discrete units (fig 14), at least some of the units having a curved configuration, the units having the ability (i.e. configured and aligned) to form the modular structure in a first configuration, and the units having the ability of being separable to disassemble the modular structure (if it can be assembled, it can be disassembled), wherein the units have the ability (i.e. are configured and aligned) to be interchangeable with units from other modular structures in at least a second configuration, wherein the first configuration is different from the second configuration (i.e. the individual units have the ability to be interchanged with other individual units to form a different configuration). The modular structure has the ability (i.e. is configured) to be joined with another modular structure to form a larger modular structure or a second modular structure. A portion of the panels (reference 46a and 46b) have the ability (i.e. are configured) to be removed from an interior of the modular structure to form ports and are hinged to form an entry point of the modular structure. The frame and shell has the ability (i.e. is configured) to form an elongate

shape with a first end area and an opposite second area. The modular structure further comprising at least three steel (i.e. armored) sides. With regards to claim 72 and 73, leaving one of the sides off would constitute a means for coupling because that side could be extended in a different configuration using any one of the disclosed connectors. The base, the at least three armored sides and the open end form a self-supporting structure. One of the at least three sides has the ability (i.e. is configured) to be removed during use of the structure. With regards to claims 74 and 64-71, the modular structure comprises a first frame formed from a plurality of frame portions; a first shell formed from a plurality of steel panels (i.e. armored panels), the first frame and first shell forming a first modular section having a bottom surface, a top surface and at least three sides and forming a first elongate structure, each of the panels forming the first shell forms at least a portion of the interior surface and exterior surface of the first modular section having no void between the interior surface and the exterior surface, any of the disclosed connectors comprising first coupling means arranged on the first modular section and having the ability (i.e. configured ) for joining the first modular section with at least one other modular section. Any number of the units can be built and with the modularity of the units they have the ability (i.e. are configured) to be joined. Danhof does not expressly teach joining the sheds or configuring the sheds into a different configuration, Paz teaches an extendible shed (i.e. modular structure) in which the discrete units are joined in a variety of configurations in order to customize the size and shape of the shed. It would have thus been obvious to one having ordinary skill in the art to reconfigure the modular structure of Danhof into any size or shape

desired by the user of the product to achieve the claimed invention because a person of ordinary skill would have been motivated to combine the teaching of changing configurations of size and shape as taught by Paz and there would have been a reasonable expectation of success. The [a)statements of intended use or field of use, b)"adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"] clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

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As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached PTO-892 – Notice of References Cited form.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan C. Weber whose telephone number is

(571)270-5377. The examiner can normally be reached on Monday-Friday 8:30AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on (571)272-6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. C. W./  
Examiner, Art Unit 3641

/Troy Chambers/  
Primary Examiner, Art Unit 3641